



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/507,242

01/27/2005

Ken Sakata

Q83383

9079

23373 7590 05/16/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LAM, CATHY FONG FONG

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/507,242

Applicant(s)

SAKATA ET AL.

Examiner

Cathy Lam

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-27-05, 7-5-05, 9-10-05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Specification

1. The disclosure is objected to because of the following informalities: on page 27 line 2, the term "patter" is believed as an error.

Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "11" and "12" have both been used to designate conductor layer as on page 31, last paragraph. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

3. The information disclosure statement filed on September 10th 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been

Art Unit: 1775

considered. JP reference 61-50394 does not include an English abstract translation as it has stated on the IDS. Applicant is required to submit an English abstract when respond to this office action.

Claim Rejections - 35 USC § 112

4. Claims 12, 13, 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, "the wiring pattern" lacks antecedent basis.

Claim 13 is structurally indefinite, as it is unclear what "a plurality of strips of the layer correspond to the wiring patterns" is referring to?

In claims 14 and 20, it is structurally indefinite, as to whether the adhesive layer is between the transfer film substrate and the transferable releasing layer? The phrase "can be exclusively released from the transferable releasing layer" is indefinite.

Clarification is required.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1775

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Braun et al (US 5281455) or Konno et al (US 5073422) or Morgan (US 3554835) or Ayres (US 3503782).

It is noted by the Examiner that some claims are drafted in a product by process format. It is the product itself which must be new and unobvious. Unless some unexpected result is shown that occurs due to Applicant's specific process(es), different processing steps are not patentably distinguishing for claims to an article.

Furthermore, claims 1 and some dependent claims involve intended use language, such as "for forming a component of a COF flexible...." And "can be transferred onto the insulating layer". Applicant is reminded that these language have no weight to the article actually being claimed.

Applicant in claims 1-16 is claiming a releasing layer transfer film comprised of a transfer film substrate, an adhesive layer (as in claim 14), a transferable releasing layer and a peelable film (as in claim 16).

Braun discloses a releasable laminate comprised of a silicone pressure sensitive adhesive (10) containing a fluorosilicone release coating (11) and a peelable backing (12).

The release coating (11) and the peelable backing (12) form a liner (21 which is releasably adhered to the silicone pressure sensitive adhesive (10) (col 2 L 45-47). The release coating (11) is a fluorosilicone adhesive release coating composition which is formed over a backing layer (12) (col 13 L 65-col 14 L 9).

Art Unit: 1775

Konno also teaches a laminate structure comprised of a pressure sensitive layer, a release agent layer and a substrate layer; all in this order (col 3 L 33-35 & Fig. 2).

The release agent layer is a fluorosilicone compound (col 5 L 56-57).

Morgan teaches a laminate comprised of a backing sheet (1), a release layer (3) and release dots (2), a pressure sensitive adhesive (4) and a plastic film (5) (Fig. 3).

The release layer (3) is first formed over the entire surface of the backing sheet then the release dots (2) are formed onto the release layer (3) coated backing sheet (1).

The backing sheet (1) is peelable and when peeling it takes the release layer (3) away, leaving the release dots (2) on the pressure sensitive adhesive (4) (Fig. 4).

Morgan discloses a patterned release layer (i.e. the release dots (2)).

Ayres teaches a release paper comprised of a release agent that is coated onto a paper substrate (10). The release agent is a polysiloxane or a silane compound (col 2 L 69-col 3 L 2, col 4 L 25).

Release agent coating (11&12) are first formed over both surfaces of the paper substrate, then a release agent in a desired pattern is formed over one of the release agent coating (Figs. 1 & 3 & col 6 L 28-35).

All of the prior art teach a release layer over a film substrate; an adhesive may be formed over the release coating layer. The release coating layer can be a continuous or a patterned layer.

Applicant includes some functional language in the claims, the examiner takes the position that it would be inherent that some of the functional limitations would

inherently be met, such as any additional layer(s) added to a substrate or a film would reinforces the structure due to the increase in thickness.

Claim Rejections - 35 USC § 103

8. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al (US 5281455) or Konno et al (US 5073422) or Morgan (US 3554835) or Ayres (US 3503782).

The prior art teach a laminate comprised of a release coating layer, a film substrate and a pressure sensitive adhesive, all in the named order. The film substrate acts like a liner can be peeled from the pressure sensitive adhesive.

The prior art however do not teach the laminates are coupled with a flexible PWB.

In view of the prior art teachings, one skill in the art would use a releasable laminate over a flexible PWB because it eases processability and transporting.

Double Patenting

9. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,900,989.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are structurally and materially the same.

10. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/386,116. Although the conflicting claims are not identical, they are

Art Unit: 1775

not patentably distinct from each other because they are structurally and materially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (571) 272-1538.

The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cathy Lam
Primary Examiner
Art Unit 1775

cfl
May 04, 2006